



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,182	02/10/2000	Sivan Tafla	10980/010001/122315.5	4849

20985 7590 09/09/2002

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 09/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/502,182

Applicant(s)

TAFLA, SIVAN

Examin r

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the citizenship of each inventor.

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-13, 15-17, 19, 20, 45, 46, 49 and 50 are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims merely set forth structure to, or methods for downloading either a webpage, advertising layer or both. No structure or steps are set forth for actually

repeat
see
notes

Art Unit: 3622

displaying or triggering the animation which overlays the webpage. Simply downloading object(s) does not result in a useful and tangible result; therefore these claims do not represent statutory subject matter. The functional language of a layer adapted to contain animated content "adapted to run across a webpage" does not clearly and positively set forth such running across a webpage. Similarly, downloading a layer "for displaying the animated content" does not actually include the positive displaying of the content. To avoid this rejection, applicant should clearly set forth structure or steps displaying/triggering the display of the animated content on top of a displayed webpage.

Double Patenting

3. Applicant is advised that should claims 45, 47 and 49 be found allowable, claims 46, 48 and 50 respectively will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3622

5. Claims 5, 15, 27 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- There is no enabling disclosure for providing an animated video clip which travels across the screen.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7, 10, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

■ Claims 7 and 17, there is no antecedent basis for the trigger signal.

■ Claim 10 and 19, it is unclear how a download can take place during an idle period; such a time period is therefore, not idle.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 4-9, 11, 12, 14-18, 20-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Zapa Digital (WO 97/35280).

Regarding claims 1, 12, 45-50, Zapa Digital teaches systems and methods for downloading an animated layer which is superimposed over a web page shown in a web browser (e.g. yahoo! Webpage) [fig 2, 6A, 6B, pg 25 lines 23-25]. Zapa Digital describes the animation as advertising content [pg 32 lines 30-31]. The animated object(s) move across the screen portions [pg 25 line 35 to pg 26 line 5, pg 17 lines 19-25] and the web page underneath is fully active and responsive, save for the portion covered by the boundary of the animated object.

Regarding claims 4, 7-9, 17, 18, 21-26, 29-31, 33-38, 41-43, Zapa Digital teaches that the triggering of various animations can be accomplished by programming integral with the animation object itself, or by external, programmed scripts [pg 18 lines 7-13]. The animations can be triggered without interaction by the user, such as proximity of one character in relationship to another or collisions, or by user-action such as mouse selection [pg 6 lines 24-36, pg 23 lines 22-26]. Zapa Digital also teaches animations to be triggered by the server through the use of a downloaded mobile program (JAVA server applet) [pg 34 lines 29-31]. Regarding claim 14, the server's processor which sends the JAVA-based triggers is inherently responsive to a clock.

Regarding claims 5, 15, 27 and 39, the animation portions are taken to be "video clips", as they are visual portions of displayed motions.

Regarding claim 6, 16, 28 and 40, the smart objects that comprise the animated objects are taken to be animated by way of vector scripts. The objects include

mathematical descriptions of the image element as well as data describing the position, orientation and motion of such object from one animation frame to the next [pg 4 lines 18-20, pg 5 lines 3-8, pg 6 lines 29-31].

Regarding claims 11, 20, 32 and 44, Zapa Digital describes portions of the animated objects as partly transparent (translucent) so that the underneath content is visible [pg 25 lines 21-25].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 3, 10, 13, 19 and alternatively claims 5, 15, 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zapa Digital.

Regarding claims 2 and 3, Official Notice is taken that providers of web content also provide advertising themselves, or by a third party. It would have been obvious to one of ordinary skill at the time of the invention to have provided the advertising methods of Zapa Digital from either the content server or by a third party advertising server, so that additional revenue can be generated.

Regarding claims 5, 15, 27 and 39, it would have been obvious to one of ordinary skill at the time of the invention to have provided any type of known digital animation formats with the moving objects of Zapa Digital, including video clips and animated gifs,

for example. Further, applicant provides no criticality to the types of format, be it vector-based or video clips. Applicant's claiming of either type of format suggests a lack of criticality to this feature.

Regarding claims 10, 13 and 19, Zapa Digital teaches overlaying the animation on top of a webpage. It is believed to be inherent, if not obvious to one of ordinary skill at the time of the invention, to have first downloaded and rendered the webpage before the animation layer is downloaded and rendered. In this manner, the animated layer can be superimposed on top of the existing webpage. As best understood, doing so would ensure that the animated layer was downloaded during an otherwise idle period (i.e. the webpage has already been downloaded for user display).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Blossom et al (US5546518) teaches methods for creating overlapping layers of animated objects on a computer screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
September 5, 2002